

REMARKSStatus of the Claims

Claims 33 and 34 are currently pending in the present application. Claims 1-32 have been canceled without prejudice or disclaimer of the subject matter claimed therein.

Claims 33 and 34 have been amended. Applicants note that the exclusionary limitation added to claims 33 and 34 merely helps to distinguish the claimed invention from the prior art. As held by the court in *In re Johnson*, excluding from a genus, a limitation that is expressly recited in the specification is not prohibited new matter. *In re Johnson and Farnham*, 194 USPQ 187, 196 (CCPA 1977).

Copied Claim for Provoking an Interference

This application was filed on August 29, 2001, with claims copied from U.S. Patent 6,162,258, for the purposes of provoking an interference. Applicants respectfully point out that the references cited in the Office Action, dated February 26, 2008, are equally applicable to U.S. Patent 6,162,258 as prior art. Accordingly, in accordance with MPEP 1003, item #6, the Office Action dated February 26, 2008 should have been submitted to the Technology Center Director for consideration and signature before mailing to Applicants.

Applicants respectfully request that the next communication from the Patent Office be submitted to the Technology Center Director for consideration and signature prior to mailing to Applicants.

Rejection Under 35 U.S.C. § 102(e)/§ 103

Claim 34 has been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,899,939 (Boyce) or alternatively under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 5,899,939 (Boyce).

The Office Action alleges that Boyce discloses a lyophilized monolithic bone implant comprising glucose. Claim 34, as amended, does not encompass a lyophilized monolithic bone implant comprising glucose. Accordingly, the bone implant of Boyce and the bone implant of the present invention are patentably distinct implants. Since Boyce neither teaches nor suggests the claimed invention, Boyce does not anticipate or render obvious the claimed invention.

Rejection Under 35 U.S.C. § 103

Claim 33 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,899,939 (Boyce) in view of U.S. Patent 5,333,626 (Morse).

The deficiencies of Boyce are discussed immediately above. Moreover, Boyce, does not disclose the claimed invention because Boyce only teaches filling the bone implant with substances that will promote or accelerate new bone growth. The secondary reference, Morse, does not overcome the deficiencies of Boyce, because Morse only teaches treating the bone to preserve sterility and biologic potential for transplantation. Morse is only concerned with treating the bone with decontaminating agent effective to inactivate bacteria, fungi, virus, and parasites. Accordingly, there is no reason to combine the teachings of the cited references and to make the necessary changes to the teachings of the cited references to obtain the claimed invention with reasonable expectation of success. Thus, the cited references do not render the claimed invention obvious.

Conclusion

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request entry of the amendments, reconsideration, and the timely allowance of the pending claims. A favorable action is awaited. Should an interview be helpful to further prosecution of this application, the Examiner is invited to telephone the undersigned.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Morgan, Lewis & Bockius LLP



Sally P. Teng
Registration No. 45,397

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Morgan, Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-5734